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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,307	08/29/2006	Stefan Schafer	SCHAFER, S. ET AL-2 PCT	4534
25889	7590	04/06/2009	EXAMINER	
COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			MENON, KRISHNAN S	
			ART UNIT	PAPER NUMBER
			1797	
			MAIL DATE	DELIVERY MODE
			04/06/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/587,307	<b>Applicant(s)</b> SCHAFFER ET AL.	
	<b>Examiner</b> Krishnan S. Menon	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 7-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/26/06</u>   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Claims 1-16 are pending, of which claims 7-16 are withdrawn as of 2/6/09.

### ***Election/Restrictions***

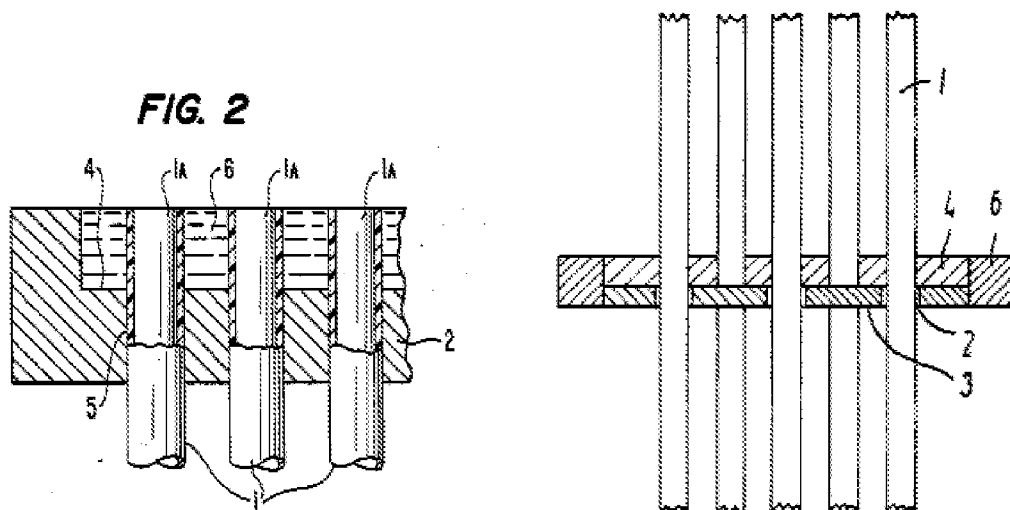
Applicant's election with traverse of claims 1-6 in the reply filed on 2/6/09 is acknowledged. The traversal is on the ground(s) that there is no additional burden of searching the non-elected claims, and that having two different patents instead of having a compact prosecution of all claims together would create unnecessary burden to the public in searching and costs to the applicant. This is not found persuasive because: the Examiner appreciates applicant's concern on the search burden to the public and the cost of prosecution of an additional application. However, the search on the Examiner is not any different, and the restriction requirement would in fact make the prosecution compact - applicant by having made this election can rejoin the process claims, which are recited as depending from the product claim 1, when the product claims become allowable.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102/103***

1. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by, or in the alternative, under 35 USC 103(a) as being obvious over, Shibata et al (US 4,902,419) or Geleff et al (US 5,840,230)

Fig 2 of **Shibata** is copied herein. As is distinctly clear, Shibata has tubular porous membranes (1), which are in the hollow fiber range because it has diameter of 3 mm (C3, L20-25), inserted through a spacer layer (2) and protrudes through an adhesive layer (6), and are open above this adhesive layer. The question of “protruding outside the adhesive layer” is debatable – tubes (1) appear to be in flush with the adhesive layer (6), but it some degree of protrusion must be there to prevent the adhesive from flowing into the tubes. Thus, making the tubes protrude would be obvious, if not anticipated.



**Figure 2 of Shibata is to the left; Fig 1 of Geleff to the right.**

Also, hollow fibers are tubular, and thus a recitation of hollow fiber would not be distinguishable over a teaching of tubular membranes.

Figure 1 of **Geleff** is also shown herein. Hollow fibers (1) are inserted through perforated plate 3 and then the potting compound (4) is filled in. The reference teaches

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(abstract) removing the plate after the potting compound cures, but the claims are anticipated by the intermediate product at the stage of the cured potting compound.

2. Claims 1-6 are rejected under 35 U.S.C. 102(b) as anticipated by, or under 35 USC 103(a) as being being unpatentable over Mahendran et al (US .6,294,039)

Mahendran teaches (Fig 2, shown below, with descriptive details starting at C8, L 47) a spacer layer of flexible spacer material, powdered salt or PEG wax is filled up to L1, above layer 15, and then potting compound above it up to level L2 and optionally a cushioning material is then filled up to level L3. Thus, Mahendran has the spacer, and above it the potting material, etc., and the tubes protrude on both sides of the spacer. Thus Mahendran anticipates the claims.

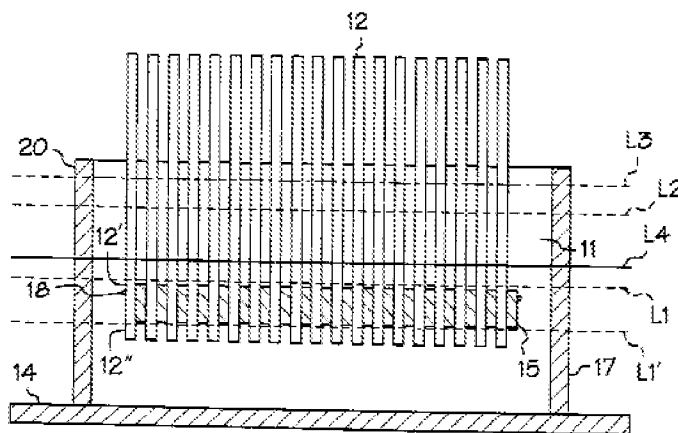


FIG. 2

Applicant's recitation of the functional layer appears to be for the purpose for fabrication, which would not be adding to the structure of the product. Mahendran teaches such functional materials in the form of the powder or PEG gel below line 11,

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which does not stay with the finished product. Thus, if the functional material remains in applicant's product, it would be only an obvious variation of the teaching of Mahendran.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S. Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vickie Kim can be reached on 571-272-0579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Krishnan S Menon/  
Primary Examiner, Art Unit 1797